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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,922	12/19/2000	Dan Vassilovski	990092	4872
23696	7590	02/27/2006	EXAMINER	
QUALCOMM, INC			HASHEM, LISA	
5775 MOREHOUSE DR.			ART UNIT	
SAN DIEGO, CA 92121			PAPER NUMBER	
			2645	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/739,922		VASSILOVSKI, DAN	
	Examiner		Art Unit	
	Lisa Hashem		2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The evidence to show common ownership between the instant application and U.S. Patent No. 6,477,150 by Maggenti et al filed 12-2-2005 is sufficient to overcome the prior art.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 11, 21, 31, 41, and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of these claims including the following limitation: ‘...a method of transitioning between a call in a first state and a second state...’. The body of these claims including the limitation: ‘...establishing a new call using the number corresponding to the second state...’. This does not support the preamble. The preamble only mentions one call being transitioned, whereas the body of the claims discloses a new call being established in the second state. Appropriate action is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,169,799 by McIntosh, in view of U.S. Patent No. 4,490,583 by Bednarz et al, hereinafter Bednarz.

Regarding claim 1, Bednarz discloses a communication device (Fig 1A, 31) operable in at least two states, a method of transitioning between a call in a first state (e.g. first call; telephone user dials number to be called) and a second state (e.g. making a new or second call and bridging the first call and new call together), each state having an associated number, each number inherently having a prefix portion and a suffix portion, the call having at least one called party (e.g. called party in another telephone network) and a calling party (e.g. telephone user of Station S1) (col. 7, lines 25-64; col. 10, lines 1-40), the method comprising:

requesting a change of state (e.g. this step read on the user of Bednarz placing an existing call on hold and selecting a new line for dialing the second telephone number; col. 9, lines 17-28; col. 10, lines 34-39);

sending at least the suffix portion of the number corresponding to the second state to the calling party (e.g. receiving a second telephone number and dialing an additional outgoing call);

and establishing a new call using the number corresponding to the second state (col. 10, lines 1-40).

Examiner takes *official notice* that it would be obvious for the called party to subscribe to multiple lines and for the called party's communication device to be operable in more than one state, that is having more than one number (as noted in Specification of the instant application; 'Related Art' on page 1, lines 14-24). When the calling party calls the called party on a first line of the called party's communication device, the called party can verbally inform the calling party

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of a second line of the called party's communication device. Wherein, the first line and second lines have corresponding telephone numbers. The calling party can call the second line by placing the first line on hold and then conference in both the first line and the second line. It would be obvious to one of ordinary skill in the art to modify Bednarz to include the called party having more than one telephone line and the called party informing the calling party of a second telephone number corresponding to a second telephone line. One of ordinary skill in the art would have been lead to make such a modification to transition between a first state and a second state and send a telephone number to a calling party in order for the calling party to know how to transition to a second state.

McIntosh discloses a communication device (e.g. calling party's telephone) (Fig. 1; col. 3, lines 15-44) operable in at least two states (e.g. a first call and a second call), a method of transitioning between a call in a first state and a second state (e.g. making a first call and then making a second call), each state having an associated number (e.g. dialed telephone number), each number having a prefix portion and a suffix portion (e.g. area code and called party number), the call having at least one called party and a calling party, the method comprising (col. 2, lines 3-50): requesting a change of state (e.g. making a second call); sending at least the suffix portion of the number (e.g. 7 digit telephone number) corresponding to the second state (e.g. second call) to the calling party's telephone (e.g. communication device);

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comparing the number corresponding to the first state (e.g. 10 digit telephone number) with the number corresponding to the second state (e.g. 7 digit telephone number);
appending the prefix portion of the number corresponding to the first state with the suffix portion of the number corresponding to the second state; and
establishing a new call using the number corresponding to the second state (col. 3, line 45 – col. 4, line 46; col. 7, line 66 – col. 8, line 29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Bednarz to include determining a dialing prefix for a suffix portion of a number of a second state as taught by McIntosh. One of ordinary skill in the art would have been lead to make such a modification to include programming in the communication device to store predetermined numbers including the prefixes and suffixes, wherein when a suffix is only dialed the communication device can compare the suffix with other numbers in memory and append a prefix to the suffix to form a number corresponding to a second state.

Regarding claim 2, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses comprising storing the number corresponding to the first state in memory associated with the calling party (Fig. 4; col. 3, line 45 – col. 4, line 24).

Regarding claim 3, the method as set forth in claim 1 mentioned above, wherein Bednarz further discloses comprising establishing a call in the first state prior to requesting a change of state (col. 7, lines 25-64; col. 10, lines 1-40).

Regarding claim 4, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses the prefix portion (Fig. 4, 210) comprises regional codes and the suffix portion (Fig. 4, 220) comprises the telephone number.

Regarding claim 5, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses the first state is a clear state (e.g. no match of number in memory) and the second state is a secure state (e.g. match of number in memory) (col. 3, line 45 – col. 4, line 46).

Regarding claim 6, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses the first state is a secure state (e.g. match of number in memory) and the second state is a clear state (e.g. no match of number in memory) (col. 3, line 45 – col. 4, line 46).

Regarding claim 7, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses the first state is a voice state (e.g. calling party speaks phrases into mouthpiece) and the second state is a data state (e.g. dialing a seven digit phone number) (col. 3, line 45 – col. 4, line 46).

Regarding claim 8, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses the first state is a data state (e.g. dialing a phone number that is matched in memory) and the second state is a voice state (e.g. calling party speaks phrases into mouthpiece) (col. 3, line 45 – col. 4, line 46).

Regarding claim 9, the method as set forth in claim 1 mentioned above, wherein McIntosh further discloses the first state is a first phone number (e.g. 10 digit phone number) and the second state is a second phone number (e.g. 7 digit phone number) (col. 3, line 45 – col. 4, line 46).

Regarding claim 10, the method as set forth in claim 1 mentioned above, wherein

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McIntosh further discloses the calling party and the at least one called party are on a wireless call (col. 3, lines 20-24).

Regarding claims 11-20, 21-30, and 31-40, please see the rejection of the method in claims 1-10 above to reject the method in claims 11-20, 21-30, 31-40, respectively.

Regarding claim 41, Bednarz discloses an apparatus (Fig 1A, 31; col. 3, line 50 – col. 5, line 68) configured to transition between a first state (e.g. first call; telephone user dials number to be called) and a second state (e.g. making a new or second call and bridging the first call and new call together) during a call, each state having an associated number, each number inherently having a prefix portion and a suffix portion, the call having at least one called party (e.g. called party in another telephone network) and a calling party (e.g. telephone user of Station S1) (col. 7, lines 25-64; col. 10, lines 1-40), the apparatus comprising:

a receiving configured to receive a request of change of state (e.g. this step read on the user of Bednarz placing an existing call on hold and selecting a new line for dialing the second telephone number; col. 9, lines 17-28; col. 10, lines 34-39);

and an establisher configured to establish a new call using the number corresponding to the second state (e.g. dialing an outgoing call) (col. 10, lines 1-40).

Examiner takes *official notice* that it would be obvious for the called party to subscribe to multiple lines and for the called party's communication device to be operable in more than one state, that is having more than one number (as noted in Specification of the instant application; 'Related Art' on page 1, lines 14-24). When the calling party calls the called party on a first line of the called party's communication device, the called party can verbally inform the calling party

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of a second line of the called party's communication device. Wherein, the first line and second lines have corresponding telephone numbers. The calling party can call the second line by placing the first line on hold and then conference in both the first line and the second line. It would be obvious to one of ordinary skill in the art to modify Bednarz to include the called party having more than one telephone line and the called party informing the calling party of a second telephone number corresponding to a second telephone line. One of ordinary skill in the art would have been lead to make such a modification to transition between a first state and a second state and send a telephone number to a calling party in order for the calling party to know how to transition to a second state.

Bednarz discloses an apparatus operable in at least two states. However, Bednarz does not disclose a comparer and a grouper.

McIntosh discloses an apparatus (e.g. calling party's telephone) (Fig. 1; col. 3, lines 15-44) configured to transition between a first state and a second state during a call (e.g. making a first call and then making a second call), each state having an associated number (e.g. dialed telephone number),
each number having a prefix portion and a suffix portion (e.g. area code and called party number),
the call having at least one called party and a calling party,
the apparatus comprising (col. 2, lines 3-50; col. 3, lines 32-44; col. 4, lines 25-46):
a receiver configured to receive a request of a change of state (e.g. making a second call);

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a comparer configured to compare the number corresponding to the first state (e.g. 10 digit telephone number) with the number corresponding to the second state (e.g. 7 digit telephone number);

a grouper coupled to the comparer configured to append the prefix portion of the number corresponding to the first state with the suffix portion of the number corresponding to the second state; and

an establisher configured to establish a new call using the number corresponding to the second state (col. 3, line 45 – col. 4, line 46; col. 7, line 66 – col. 8, line 29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Bednarz to include a comparer and grouper as taught by McIntosh. One of ordinary skill in the art would have been lead to make such a modification to include programming in the apparatus to store predetermined numbers including the prefixes and suffixes, wherein when a suffix is only dialed the communication device can compare the suffix with other numbers in memory and append a prefix to the suffix to form a number corresponding to a second state.

Regarding claim 42, the apparatus set forth in claim 41 mentioned above, wherein McIntosh further discloses the receiver is further configured to receive the number corresponding to the second state from the calling party (col. 4, lines 25-46).

Regarding claim 43, the apparatus set forth in claim 41 mentioned above, wherein McIntosh further discloses a storage device configured to store the number corresponding to the first state in memory associated with the calling party (Fig. 4; col. 4, lines 5-18).

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Regarding claim 44, the apparatus set forth in claim 41 mentioned above, wherein Bednarz further discloses the establisher is configured to establish a call in the first state prior a change of state (col. 7, lines 25-64).

Regarding claims 45-51, please see the rejection of the method in claims 4-10 above to reject the method in claims 42-51, respectively.

Regarding claim 52, please see the rejection of the method in claims 11 and 13 above to reject the method in claim 52.

Regarding claim 53, please see the rejection of the method in claims 11-13 above to reject the method in claim 53.

Regarding claim 54, please see the rejection of the method in claims 41-43 above to reject the method in claim 54.

Regarding claim 55, please see the rejection of the method in claims 41-44 above to reject the method in claim 55.

Response to Arguments

6. Applicant's arguments with respect to claims 1-55 have been considered but are moot in view of the new ground(s) of rejection.

7. Accordingly, this action is **NON-FINAL**.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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- U.S. Patent No. 6,035,026 by Kim discloses a communication device operable in at least two states and a method of transitioning between a first state and a second state (e.g. two-conference and three-way conference)
- U.S. Patent No. 6,963,640 by Manning discloses a telephone dialer including a table in memory for determining a dialing sequence such as a long distance carrier code to be appended to a dialed telephone number

9. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications


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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



lh

February 5, 2006



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